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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/687,581 | 10/20/2003 | Xavier Blin | 231036US0 | 2539 |
| 22850 7590 01/10/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | EXAMINER KANTAMNENI, SHOBHA | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1617 | |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

DETAILED ACTION

This Office Action is in response to the application filed on 10/20/2003. Claims 1-31 are pending.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15 (in part), claims 16-17, claims 26-30 (in part), drawn to a composition comprising in a cosmetically acceptable medium at least one oily phase and at least one photochromic organic dye of formula (I) or (II), wherein the oily phase comprises at least one oil as in claims 16-17, classified in class 514, subclass 183, 506, 715, 724, 762; class 424, subclass 69, 400.
- II. Claims 1-15 (in part), claims 18-25, claims 26-30 (in part), drawn to a composition comprising in a cosmetically acceptable medium at least one oily phase and at least one photochromic organic dye of formula (I) or (II), wherein the oily phase comprises at least one phenylsilicone oil of formula (VI) as in claim 18, classified in class 514, subclass 183; class 424, subclass 70.12, 79, 400.
- III. Claim 31 drawn to a process for treating a support comprising applying the composition of claim 1 to the support, classified in class 514, subclass 844.

Inventions I-II are unrelated to each other. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have

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different modes of operation, different functions, or different effects (MPEP 806.04, MPEP 808.01). In the instant case the oils of Groups I-II differ by a significant structural feature, having different formula. Given the fact that chemical compounds that are not similar in structure have different physical, chemical, and physiological properties or activities, the instant compositions are deemed to have different modes of operation, different functions, and different effects.

Inventions I-II, and III are related as product, and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case a composition comprising photochromic organic dye can be used in lens.

Each above product, and method of using the product relates to a separate and distinct area of cosmetic technology. Also each group listed above involves compounds which are recognized in the art as being distinct because of their diverse chemical structure and properties.

Further, a search for the invention of the 3 groups would not be coextensive because a search indicating the process is novel or unobvious would not extend to a holding that the product itself is novel or unobvious; similarly, a search indicating that the product is known or would have been obvious would not extend to a holding that the process is known or would have been obvious. Therefore, restriction for examination purposes as indicated is proper.

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Moreover, the search for inventions of Groups would place an undue burden on the Office because of their separate classification crossing class 514. It is noted that for example a reference to one oil such as liquid paraffin would not be a reference to another silicone oil under 35 U.S.C. 103(a). The searches are not co-extensive as indicated by the diverse nature of the subject matter. The search for all inventions would place an undue burden on the office in view of the diversity of compositions, and method, and the corresponding diversity in the field of search for each. Note that the search involves both patent and non-patent literature.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one or more claim remaining in the application. Any amendment of inventorship must be accompanied by request under 37 CFR 1.48(b) and by fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance

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with the provisions of MPEP § 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

A telephone call to the applicant's agent to request an oral election was not made, due to the complexity of the restriction.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shobha Kantamneni whose telephone number is 571-272-2930. The examiner can normally be reached on Monday-Tuesday, Thursday-Friday, 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Shobha Kantamneni
Patent Examiner
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SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER